

REMARKS

In an Office Action dated August 8, 2005, the Examiner rejected claims 17-25, 27-30 and 32-43. Applicants request that the Examiner reconsider the rejection and favorably consider newly presented claims 59-83 in light of the following discussion.

Preliminary Issues

Preliminarily, Applicants note that on December 7, 2005 a Notice issued indicating that a reply filed on September 23, 2005 was not fully responsive. However, Applicants have not filed a response to the August 8, 2005 Office Action. In a teleconference in December, the Examiner indicated that the papers dated September 23, 2005 were apparently a portion of the papers submitted by Applicants in connection with the Request for Continuing Examination.

Applicants note that the Examiner previously indicated that dependent claims 26 and 31 were allowable over the prior art of record. Accordingly, newly presented claim 59 corresponds to previously present claim 26 and newly presented claim 66 corresponds to previously presented claim 31. Accordingly, Applicants request that the Examiner favorably consider newly presented claims 59 and 66 along with dependent claims 60-65 and 67-72.

There is No Motivation to Select and Combine the Elements of Stevens '273 and Miller as Suggested in the Office Action

Turning now to claims 17-25, 27-30 and 32-43, as previously discussed, Stevens and Miller do not teach or suggest the features of the claims because the proposed combination is contrary to the teachings of the references. The combination as set forth in the Office Action simply picks and chooses elements from the references without regard as to whether there is any teaching or suggestion in the references to make the proposed combination.

The Federal Circuit has repeatedly emphasized the importance of showing evidence of a motivation to combine the prior art references in the manner suggested. It is not enough to say that one would or could combine references in a particular way. It is the Examiner's burden to provide "actual evidence" of the motivation. In re Dembiczak, 50 U.S.P.Q. 2d 1614,1617 (Fed. Cir. 1999). According to the Federal Circuit:

Combining prior art references without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blue print for piecing together the prior art to defeat patentability—the essence of hindsight.

Id.

In In re Dembiczak, the inventor had created a trash bag made of orange plastic and decorated with lines and facial features, so that when the bag was filled it resembled a jack-o-lantern. The Examiner erroneously combined a conventional prior art plastic trash bag with an article teaching the construction of stuffed paper bags decorated to look like jack-o-lanterns. The combination was erroneous because there was no teaching in the references to modify the teachings in the way that the inventor had so done. The fact that both references was directed to bags was not enough. Why would someone think to combine features of a large orange trash bag and a small decorated arts and crafts paper bag?

Similarly, the Examiner appears to pick and choose elements from Stevens '273 and Miller just because they are both devices that process document. However, as discussed below, Stevens '273 teaches reasons not to combine the two. Accordingly, since there is no "actual evidence" of combining the references in the way suggested by the Examiner, the combination of Stevens '273 and Miller is not proper.

The rationales for combining the elements proposed in the Office Action are not accurate and/or not suggested by the references

The rationales provided in the Office Action for choosing and combining select feature of Stevens '273 and Miller '169 is not provided in any of the references. It is simply made up. Further still, the purported rationale is not accurate.

For instance, on page 5, the Office Action states that it would be obvious to omit the automated document extractor because removal saves the capital costs associated with the automated extractor. There is no evidence that this is true. In fact, omitting the automated document extractor would likely increase the capital costs because a supplemental feeder would be necessary.

Referring to Fig. 6, the Stevens '273 extraction station 30 includes a rotating suction cup 37, a receiver 33, a pivoting deflector 50, and a pair of thickness measuring devices 60,61. The extraction system in Miller '169 is comparably complex. The Miller system includes a pair of vacuum manifolds 23, 24 along a support plate and a system of pinch roller 32 and belts 33 that transport the envelope so that the faces of the envelope engage a separator track 35. A sensor control assembly 30 confirms that the documents have been removed from a envelope. The sensor control assembly includes a plurality of photo-detectors and light sources that are operable as thickness detectors (c.9 lines 5-15).

Since the complexity of the Miller '169 extraction system appears to be comparable to the extraction station 30 of Stevens '273, there does not appear to be any capital savings by omitting the Stevens extraction station and replacing it with the Miller '169 extraction system as proposed in the Office Action. Further still, substituting the Stevens '273 extraction station 30 with the Miller '169 extraction system would require the addition of a secondary feeder for feeding the manually removed documents back into the system so that they can be processed (separated, selectively re-oriented

and re-ordered, and sorted). Such a feeder would further add to the capital cost.

In short, the argument that the Stevens '273 system could be modified using Miller '169 to reduce capital costs is not supported by the references and is most likely incorrect.

The second justification in the Office Action is that combining Miller and Stevens provides a reliable approach to document removal verification. Applicants do not understand this justification. There is no evidence that the Miller system provides a more reliable approach to document removal verification. In fact, the Miller reference itself points out that manual extraction generally suffers from the problem that a document may erroneously become affixed to the side of the envelope. To overcome this problem, the Miller system employs thickness detector sensors to measure the thickness of the envelope sides (c.9 lines 5-22). Interestingly, Stevens '273 also uses a thickness detector 61 to detect the thickness of the sides of the envelope to ensure that the documents were removed (c.12 lines 30-36). How can Miller provide a more reliable approach if Miller verifies removal the same way Stevens '273 does?

The third justification stated in the Office Action is that substituting the manual operation of Miller into Stevens helps in repair, upgrade and trouble shooting, as taught by Miller. First, Miller never teaches anything about a using a manual extraction system to improve repair, upgrade or trouble shoot a system. In fact, the words repair, upgrade, trouble and shoot never even appear in Miller, so Applicants' undersigned attorney do not see how Miller can teach such a motivation. Further, Applicants' undersigned attorney cannot imagine how manual extraction could help in repair, upgrade or trouble shooting of the Stevens system. Third, the Office Action never provides any explanation as to how Miller teaches such a motivation.

In the Response to Arguments, the Office Action states that breakdown, repair, upgrade and trouble shooting of portions of the system are going to result in occasions wherein the device of Stevens '273 will need to have remittances removed by hand and troubleshooting will certainly involve situations in which a device needs to have tasks performed by hand. Such statements misapprehend the operation of the Stevens '273 device and the claims.

The Stevens '273 system is a highly automated system processing upwards of 10,000 envelopes per hour. Since the system is designed to process 2 documents per envelope that is 20,000 documents per hour. On average that works out to be almost six documents every second. An operator cannot reach in and pull out a document or an envelope when the papers are moving that fast. Further, if the system is stopped and an envelope is removed, there is no way for the document to be manually re-inserted into the flow of documents.

Looking at each hypothetical situation, the Office Action proposes that upgrading the machine could require to have tasks performed by hand. What tasks? The relevant issue is whether it is obvious to combine a highly automated machine with a manual extraction process. What upgrade would require the use of manual extraction?

Further, the Office Action states that Stevens '273 teaches the modularity and interchangeability of the component subsystems, particularly the extractor (col. 5 lines 1-5). This is not true. First, Stevens '273 never says anything about interchangeability of the modules. It simply says that the different stations can be assembled from discrete modules or assembled as integral units. The main point is that some of the sub-systems described in the overall system are optional. For instance, col. 8 starting at line 9 describes a detection station that can be used to detect envelopes that have features that warrant outsourcing the envelopes. The detection system may include some or all of the detection stations.

Additionally, presumably the Office Action states that col. 5 lines 1-5 particularly teaches the modularity of the extractor because the paragraph mentions the extraction apparatus 1 (see col. 4 lines 66-67). However, this reference does not refer to the extraction station that removes the contents from the envelopes. Reference number 1 refers to the overall system—i.e. it is the number used to refer to the entire machine in Stevens '273, rather than the extraction station, which is referred to as item 30, as described in col. 10 line 11 and following. Accordingly, there is no teaching or suggestion in Stevens '273 of an interchangeable extraction station that can be simply swapped out for a different extraction station as suggested in the Office Action.

As discussed previously, if the documents are manually extracted there would need to be a separate feeder for getting the documents back into the flow of documents. Simply put, there is no motivation to combine the elements of Miller and Stevens '273 as proposed in the Office Action. The references do not teach or suggest the combination and the proposed motivations are based on erroneous facts and assumption. Accordingly, Applicants request that the Examiner reconsider the rejections.

Claim 17-25, 27-30 and 32-43 as Amended Are Patentably Distinct from Stevens '273 and Miller

Further still, claim 17 has been amended to recite the step of manually feeding the transaction of one or more documents to an imaging station. In addition to the differences discussed above, nothing in the references teaches or suggests manually feeding documents to an imaging station. Specifically, nothing in Stevens '273 teaches manually feeding extracted documents to an imaging device, and as previously stated Stevens '273 is directed to an automated machine for processing documents at a very high rate. Manually feeding documents to the imaging device would significantly slow down the operation of the system, which would be contrary to the whole purpose of the

system. Accordingly, Applicants request that the Examiner reconsider the rejection of claim 17 and dependent claims 18-24. Additionally, dependent claim 81 specifies that the step of manually feeding the transaction of one or more documents to an imaging station comprises dropping the removed document toward a transport. Clearly nothing in Stevens '273 or Miller teaches or suggests such a step.

Referring to claim 25, as amended claim 25 recites that the image device comprises an input configured to receive one or more documents manually fed into the input. Nothing in Stevens '273 or Miller teaches or suggests such a feature. Accordingly Applicants request that the Examiner reconsider the rejection of claim 25 and dependent claims 27-29. Additionally, dependent claim 82 recites that the image transport is configured to receive a document dropped toward the image transport. Nothing in Stevens '273 or Miller teaches or suggests such a features.

Referring to claim 30, as amended claim 30 recites a second transport configured to receive documents manually fed to the second transport and transport the documents to the imaging device. Nothing in Stevens '273 or Miller teaches or suggest manually feeding extracted documents to a transport and transporting the documents to an imaging device. Accordingly, Applicants request that the Examiner reconsider the rejection of claim 30 and dependent claims 32-35. Additionally, dependent claim 83 recites that the image transport is configured to receive a document dropped toward the image transport. Nothing in Stevens '273 or Miller teaches or suggests such a features.

Referring to claim 36, as amended claim 36 recites the steps of manually feeding extracted documents to a transport and transporting the document along the transport to an imaging station. As discussed above, Stevens '273 and Miller do not teach or suggest such features. Accordingly, Applicants request that the Examiner reconsider the rejection of claim 36 and dependent claims 37-43. Further, dependent claim 43 recites that the step of transporting the document toward an imaging station comprises

dropping the document toward a second transport that conveys the document toward the imaging station. Nothing in Stevens '273 or Miller suggest such features.

Referring to newly presented claim 73, claim 73 is similar to previously presented claim 17, with the addition of the step of manually feeding extracted documents to a transport that transports the documents to an imaging device. Accordingly, claim 73 is allowable for at least the reasons discussed above in connection with claim 17 as amended. Therefore, Applicants request that the Examiner favorably consider newly presented claims 73-80.

Supplemental Issues

In addition to the issues noted above, Applicants traverse the statement in the Official Action that Applicants have admitted a lack of patentable distinction in view of the traversal of the restriction requirement (see page 6 of the August 8, 2005 Office Action). Applicants reiterate that the traversal of the restriction requirement was based on the fact that the Examiner had already searched and examined previously presented claims 1-23, and then subsequently imposed a restriction requirement that separated claims 1-23 into three different categories along with claims 24-58 that were newly presented with the RCE. Applicants' contention was that by already searching and examining claims 1-23 the Examiner has admitted that the subject matter could reasonably be examined together. Further, since each of the new claims were categorized by the Examiner together with some of claims 1-23, the Examiner's own categorization showed that the new claims were closely related to the claims 1-23 so that the claims should be examined together. In short, Applicants have not made any of the admissions mentioned by the Examiner, and specifically traverse any such proposition.

Applicants also note that as discussed above, the Office Action dated August 8, 2005 did not consider all of the papers filed along with Applicants previously filed

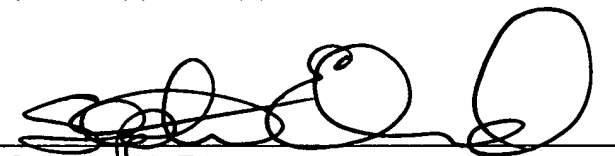
Request for Continuing Examination. Therefore, Applicants believe that the August 8, 2005 Official Action was not proper since it did not consider all of the papers filed by Applicants. Accordingly, if issues remain after consideration of the present Response, Applicants do not believe that it would not be proper for a subsequent Office Action to be made final because Applicants have not yet received an Official Action that considers all of the papers filed by Applicants.

In light of the foregoing, Applicant believes that this application is in form for allowance. The Examiner is encouraged to contact Applicant's undersigned attorney if the Examiner believes that issues remain regarding the allowability of this application.

Respectfully submitted,

DANN, DORFMAN, HERRELL & SKILLMAN
A Professional Corporation
Attorneys for Applicant(s)

By

A handwritten signature in black ink, appearing to read "Stephen H. Eland", written over a horizontal line.

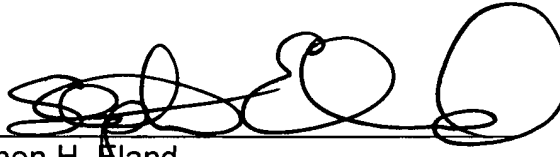
Stephen H. Eland
PTO Registration No. 41,010

Telephone: (215) 563-4100
Facsimile: (215) 563-4044

Provisional Request for Extension and Authorization to Charge Deposit Account

The Office Action dated August 8, 2005 did not indicate a shortened statutory period for response. Additionally, as stated above, Applicants have not yet filed a response to the August 8, 2005 Office Action. Therefore, Applicants do not believe that the period for this Response is dictated by the Notice dated December 7, 2005. Accordingly, Applicants' undersigned attorney believes that no extension is necessary for filing this Response. However, in the event the Commissioner determines that an extension is required for this Response, Applicants' undersigned attorney requests such extension. Additionally, Applicants' undersigned attorney believes that no fee is required in connection with this response. In the event the Commissioner determines that a fee is required, the Commissioner is authorized to charge such fee to Deposit Account No. 04-1406.

February 8, 2006
Date of Certificate



Stephen H. Eland
PTO Registration No. 41,010